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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,304	08/27/2003	Gert Kim Jensen	034896-0103	3552

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FOLEY AND LARDNER
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EXAMINER

HAAS, WENDY C

ART UNIT PAPER NUMBER

1661

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/648,304

Applicant(s)

JENSEN ET AL.

Examiner

Wendy C Haas

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1661

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(f), which papers have been placed of record in the file.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

Art Unit: 1661

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

A. The name '08.01.17' is objected to under Article 20, Paragraph (2) of the 1991 UPOV Convention because it consists solely of figures, which is not the established practice in the claimed market class.

Article 20, Paragraph (2) reads:

(2) [Characteristics of the denomination] The denomination must enable the variety to be identified. It may not consist solely of figures except where this is an established practice for designating varieties. It must not be liable to mislead or to cause confusion concerning the characteristics, value or identity of the variety or the identity of the breeder. In particular, it must be different from every denomination which designates, in the territory of any Contracting Party, an existing variety of the same plant species or of a closely related species.

The Examiner notes that the proposed name has been rejected by the Canadian Plant Breeder's Rights Office, and that applicant proposed the name 'PKMP01' for the claimed plant as an alternative name in Canada, and the same variety designation, 'PKMP01' appears to be the only variety designation proposed to CPVO. Applicants must designate one proper, acceptable variety name for the claimed plant and should use the same name for the claimed plant across all UPOV member countries, as noted in Article 20, Paragraphs (5) and (7).

Art Unit: 1661

- B. Applicants should provide the age of the plant as illustrated in the photographic illustrations and the conditions under which the illustrated plant was grown, if readily available.
- C. Applicants must clearly describe which plant in the drawing is which, should more than one cultivar be displayed (e.g. the plant on the left is 'Bob' and the plant on the right is 'Shirley'.) Finally, applicants currently describes the drawings as "[t]he first photographic drawing" and "[t]he second photographic drawing", however it appears applicants have filed four separate photographic illustrations in this application for patent. Corrections are needed.
- D. Applicants should provide the conditions under which the plant, as described in the Detailed Botanical Description, was grown. For example, applicants should note the typical and observed light levels and day and night time temperatures in the location of culture and should also provide the typical watering schedule and fertilizer application levels for the claimed plant, as described.
- E. Page 4, line 5, applicants should delete "more" as the specification must accurately describe the actual colors of '08.01.17'.
- F. Applicants should provide the typical and observed color of the roots of the claimed plant, if readily available.

Art Unit: 1661

G. Page 5, line 19, applicants describe the lateral branches of the claimed plant as “Approximately 65-75” but do not provide units or descriptors for the numbers cited. Applicants should specify whether the lateral branches are 65-75 in number, 65-75 cm in length, or something else.

H. Page 6, line 4, applicants state “dentate, cordate”. It is not understood what applicants are intending “dentate, cordate” to mean as applicants have described the leaf shape apex, base and margins on lines 5 and 6 of the same page. Correction and/or clarification is necessary.

I. Page 6, applicants should provide the typical and observed texture for the petioles of the claimed plant.

J. Page 6, lines 20-21, applicants should provide at least an average observed typical longevity (i.e. 22 days, etc.) for the flowers of the claimed plant under the conditions described in the location of culture.

K. Page 7, applicants describe the length of the flowers of the claimed plant – applicants should specify whether the description “length” corresponds to depth or something similar or is intended to indicate another botanical feature of the claimed plant.

L. Page 7, lines 5 and 6, applicants describe the petal lobes as both lanceolate and acuminate. Applicants should specify which shape accurately describes the petal lobes or should

Art Unit: 1661

note whether the lobes are some times one shape and sometimes the other or whether they are a shape somewhat between the two or something else.

M. Page 7, applicants should provide the overall petal shape.

N. Page 7, line 15, applicants set forth the color designations for the instant plant's petals. However, it is uncertain whether the colorations set forth are for the upper, lower, or both peal surfaces. Applicants should set forth in the specification color designations for both surfaces. Correction and/or clarification is necessary.

O. Page 7, lines 18-20, applicants should set forth the typical and observed margin shape for the sepals of the claimed plant.

P. Page 8, line 6, applicants should set forth the typical and observed shape of the anthers of the claimed plant, if readily available. Additionally, applicants should specify whether the 1mm measurement set forth is intended to measure length, width or something else.

Q. Page 8, line 12, applicants should specify the typical and observed number of seeds per flower, if known.

R. Applicants should set forth any known disease or pest resistance or any known susceptibility to diseases or pests exhibited by the claimed plant.

The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

Claim Rejection

35 U.S.C. § 112, 1st and 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above, and under 35 U.S.C. 112 first paragraph for the reasons advanced in the objection to the drawings.

References Cited

The references cited on the attached PTO-892 are not of record in any rejection set forth in this case and are made of record to show the state of the art. The patents cited are believed to be the most similar patented cultivars to the claimed plant.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (571) 272-0976. The examiner can normally be reached on Monday through Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

W. C. Haas

**KENT BELL
PRIMARY EXAMINER**

Kent L. Bell